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EXAMINER

GARCIA, ERNESTO

ART UNIT PAPER NUMBER

3679

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,203

Applicant(s)

O'BRIEN, JAMES RICHARD

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004 and 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

In order to avoid abandonment, the drawing informalities noted in the paper, PTO-948, mailed on 4/23/03, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be generally limited within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "first longitudinal edge and second longitudinal edge" in line 6 of claim 20 lacks antecedent basis. Applicant is reminded that basis exists fro first

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edge and second edge. Furthermore "a first side of the first rail and the second rail" in line 8-10 lack antecedent basis in the specification.

Claim Objections

Claims 3-12 and 20 are objected to because of the following informalities:

regarding claim 3, 5, 6, 8, 10 and 11, a claim in dependent form shall contain a reference to a claim previously set forth;

regarding claims 4-11, the subject matter of these claims should be directed to a fence and not a fence panel. Since claim 20 is directed to a fence and claims 4-11 directly or indirectly depend from claim 20, "panel" in line 1 should be deleted in claims 4-11;

regarding claim 12, "the edge" in line 9 should be --the first side edge or the second side edge--; and,

regarding claim 20, "the fence panel" in line 2 should be --a fence panel--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 5-9, 12-16, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hinkle, 3,456,921.

Regarding claim 20, Hinkle discloses in Figures 1 and 3 a fence comprising a first rail **15**, a second rail **16**, a pair of spaced-apart end pickets **A7** (see marked-up attachment), interior pickets **A8**, and fasteners **28-31**. The first rail **15** and the second rail **16** are disposed in parallel, spaced-apart relation to each other and define a longitudinal length of a fence panel. The first rail **15** and the second rail **16** each define respective opposing first longitudinal edge **A10** and second longitudinal edge **A11** spaced apart relative to a terrain surface **A100** (see marked-up attachment showing fig 1). The first rail **15** and the second rail **16** are disposed at an angle relative to horizontal.

The end pickets **A7** are disposed substantially perpendicular to horizontal on a first side of the first rail **15** and the second rail **16** at opposing longitudinal end portions **A12** of the first rail and the second rail thereto by a weld **28-31** between each of the end pickets **A7** and the first longitudinal edge **A10** of the first rail **15** and the second rail **16**. The interior pickets **A8** are disposed substantially perpendicular to the horizontal on the first side of the first rail and the second rail. The interior pickets **A8** are spaced-apart between the end pickets **A7**. The interior pickets **A8** are attached to the first rail and the

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second rail by a weld **28-31** between each of the interior pickets and the second longitudinal edge **A11** of the first rail and the second rail.

Applicant is reminded that functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

The end pickets and the interior pickets connect on opposing longitudinal edges of the first rail and the second rail so that the fence panel, is racked by moving opposing ends of the panel in opposing vertical directions relative to the terrain surface **A100**, conforms a slope of the first rail and the second rail substantially to a slope of the portion of the terrain surface by changing the angle between the end and inner pickets and the first and second rails while the end and interior pickets remain substantially perpendicular to horizontal without the first and second rails rolling away from the inner and outer pickets.

Applicant is reminded that the method of racking the fence panel and conforming the fence panel to a slope of the terrain surface is not germane to the issue of patentability of the fence panel itself. Therefore, this limitation has been given limited patentable weight. See MPEP ' 2113. Applicant is reminded that the fence panel of Hinkle is able to be racked by moving opposing ends of the panel in opposing directions transverse to the longitudinal axis of the rails, and the fence panel of Hinkle is able to

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conform the rails to the terrain surface by changing the angle between the pickets and the rails while the pickets remain substantially perpendicular to the horizontal without the first rail and the second rail rolling away from the inner pickets and the outer pickets.

Regarding claim 3, the fence panel further comprises a pair of end posts **12** attached to opposing ends of the first rail **15** and the second rail **16**.

Regarding claims 5, 7, 9 and 15, applicant is reminded that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Furthermore, applicant is reminded that the fence panel is able to be selectively racked during installation between about 0 degree and 20 degrees relative to the angle at which the rails are disposed when the rails and the pickets are initially attached together.

Regarding claims 6 and 14, an angle at which the first rail **15** and the second rail **16** are disposed is between about 0 degrees and 60 degrees.

Regarding claim 8, an angle at which the first rail **15** and the second rail **16** is selected from a group comprising 0 degree, 20 degrees, 40 degrees and 60 degrees.

Regarding claim 12, Hinkle discloses, in Figures 1, 3 (see marked-up attachment) and 4, a fence panel comprising a pair of rails **23,26**, inner pickets **A8**, a pair of outer pickets **A7**, and fasteners **28-31**.

The rails **23,26** are disposed parallel and spaced-apart relation and at an angle relative to horizontal. The rails **23,26** each define an opposing first side edge **15,16** and an opposing second side edge **22,25**. The rails **23,26** comprise a first rail **23** and a second rail **26**.

The inner pickets **A8** and the outer pickets **A7** are attached to the first rail **23** and the second rail **26** by the fasteners **28-31**. The inner pickets **A8** are respectively attached to the first rail **23** on the first side edge **15,16**. The outer pickets **A7** are respectively attached to the second rail **26** on the second side edge **22,25**.

Applicant is reminded that functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Furthermore, applicant is reminded that the method of racking the fence panel and conforming the fence panel to a slope of the terrain surface is not germane to the issue of patentability of the fence panel itself. Therefore, this limitation has been given limited patentable weight. See MPEP ' 2113. Applicant is reminded that the fence panel of Hinkle is able to be racked by moving opposing ends of the panel in opposing directions transverse to the longitudinal axis of the rails, and the fence panel of Hinkle is

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able to conform the rails to the terrain surface by changing the angle between the pickets and the rails while the pickets remain substantially perpendicular to the horizontal without the first rail and the second rail rolling away from the inner pickets and the outer pickets.

Regarding claim 13, the fasteners **28-31** comprise flexible mild steel welds (col. 3, lines 4-6).

Regarding claim 16, the fence panel further comprises a pair of end posts **12** attached to opposing ends of the rails **23,26**.

Regarding claim 19, Hinkle discloses a method of making a fence section. The method comprises:

a) dispose a pair of rails **23,26** parallel and spaced-apart at an angle to a horizontal plane; the rails define opposing first side edge **15,16** and opposing second side edge **22,25** relative to a terrain;

b) attach inner pickets **A8** to a side of the rails **23,26** disposed substantially perpendicular to the horizontal plane with fasteners **28-31** between the inner pickets **A8** and the first side edge **15,16** of the rails **23,26**;

c) attach a pair of opposing outer pickets **A7** to a side of the rails **23,26** at opposing ends of the rails **23,26** substantially perpendicular to the horizontal plane by

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fasteners **28-31** between the outer pickets **A7** and the opposing second side edge **22,25** of the rails **23,26**.

Applicant is reminded that functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Attachment of the inner pickets to the rails opposing the attachment of the outer pickets to the rails restrict the rails from rolling away from the inner pickets and outer pickets while racking the fence section by moving opposing ends of the fence section in opposing directions transverse to the longitudinal axis of the rails to conform a slope of the rails substantially to a slope of a portion of the terrain by changing the angle between the inner and outer pickets and the rails while the inner and outer pickets remains substantially perpendicular to horizontal.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 4, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinkle, 3,456,921 (see marked-up attachment) in view of Dye, 5,544,866.

Regarding claims 4, 11 and 17, Hinkle, discloses, the fence panel further comprises angle members **32** having a first leg **A13** and a second leg **A14**. The first leg **A13** of each of the angle members **32** is attached to a distal end of the first rail **15** or the second rail **16**. However, Hinkle fails to disclose the second leg **A14** defining a pair of holes and the fence panel further including screws extending through the holes. Dye teaches in Figures 2 and 3 a second leg **30** defining a pair of holes **26** and screws **18,20** to connect rails to posts. Therefore, as taught by Dye, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a pair of holes and screws to connect the rails to the posts.

Claims 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinkle, 3,456,921 (see marked-up attachment) in view of Conner et al., 4,898,365.

Regarding claims 10 and 18, Hinkle, as discussed above, fails to disclose the first rail **15** and the second rail **16** are four-wall tubular members. Conner et al. teach in Figures 2 and 25, a first rail **34** and a second rail **36** are four-wall tubular members to enclose the pickets entirely in order to protect the picket from the environment. Therefore, as taught by Conner et al., it would have been obvious to one of ordinary skill

in the art at the time the invention was made to make the rails four-wall tubular members as an alternative to protecting the pickets from the environment.

Response to Arguments

Applicant's arguments filed June 25, 2004 have been fully considered but they are not persuasive.

Applicant has argued that Hinkle's structure is more complicated than that of claims 12, 20 and 19 in the application. In response, there is no requirement in the statute that the invention of the reference used against applicant's invention be simple.

Applicant has also argued that the structure of the claimed invention differs from the prior art as the structure of the present invention has the inner pickets attached to a first edge of a respective rail and the outer pickets are attached to an opposing second edge of the respective rail. Alternatively, the present invention differs in that the inner pickets (interior pickets) attach to the rail on a side edge of that rail in the fence panel from rolling during the racking operation and provides a less complicated more readily constructed fence panel. In response, the examiner is aware of the functions of the structure of the present claims. However, taking a broad interpretation of the structural limitations and terms used in the claims, the claims still read on the reference. Furthermore, applicant might not have grasped the concept of Hinkle's invention as

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applied to the claims. For instance, each of the rails of the reference is fastened on both side edges of the rails whether the rails are end rails or intermediate ends. Thus the rails are fastened on either side edges. In retrospect, the inner pickets attach to the rail on a side edge of a rail opposite the side edge to which the outer pickets attach or vice versa as in the inner pickets attach to the rail on an opposite side edge of the rail opposite the side edge to which the outer pickets attach, or the rails are fastened on both sides edges of the rails.

Conclusion

Applicant's admitted prior art of record in view of the French patent FR-1,061,340, Coltrin, Pigott et al., and Sharp is considered pertinent to applicant's disclosure. It would have been obvious matter of design choice to weld the pickets of the prior art around the joint thus anticipating the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E.G.

November 8, 2004

Attachments: two marked-up copies of Hinkle, 3,456,921 showing Figure 3 corresponding to cross-sections of Figure 1.



DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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(Hinkle) 3,456,921



